

YO9-99-270
Amendment dated 4/7/2003

09/489,908

00280552aa
Reply to office action mailed 03/07/2003

REMARKS

Claims 1-27 are currently pending in the application, subject to a restriction requirement. By this amendment, claims 1, 8, 11, 14, 22 and 23 are amended for the Examiner's consideration. The foregoing separate sheets marked as "Listing of Claims" shows all the claims in the application, with an indication of the current status of each .

Further, applicant traverses the restriction requirement. The invention is a novel combination of a finger based pointing device with fingerprint recognition. Claims 1, 14, 22 and 23 have been amended to make clear that this combination is the invention claimed. This combination is particularly well suited to providing mobile computers with both security and a pointing device, since the security function – of particular concern with mobile computers – is derived from the information available via use of the pointing device without separate (and often inconvenient) attention by the user.

Consequently, a search must necessarily be done for the combination of a finger based pointing device and fingerprint authentication. It is the combination that is the invention. The fact that each element of the combination may be classified in a different class does not change the substance of the search required to examine the application.

The Examiner has argued that the invention described in claims 1-13 have a separate utility "such as authenticating a user by obtaining the contact parameter such as rotation and translation." However, the function of the "rotation and translation" relates to the pointing device functionality, not authentication. One of the novel aspects of the invention is that the fingerprint identification technology enables a determination as to "rotation and translation" usable for operation of the pointing device, as well as for defeating "replay" authentication attacks.

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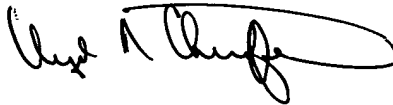
In addition, the applicant would be prejudiced because the restriction requirement would require separation of the elements whose combination provide the novelty of the invention.

In view of the foregoing, it is requested that the application be reconsidered, that claims 1-27 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax: 703-787-7557; email: clyde@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account 50-0510 (IBM-Yorktown).

Respectfully submitted,



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